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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,309	12/04/2003	Fred Bishop	60655.3200	1308
5514	7590	08/08/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			SHAH, AMEE A	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			3625	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,309

Applicant(s)

BISHOP ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-13 are pending in this action.

Response to Amendment

Applicant's Amendment and Remarks, filed May 24, 2006, have been entered. Claims 1 and 12 have been amended. In light of the amendments to the specification, the objections to the drawings are withdrawn. However, the amendments to the specification regarding trademark use do not fully comply in that the trademarks are not capitalized, and the objection remains.

Response to Arguments

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendments.

Specification

The use of the trademarks MICROSOFT, WINDOWS, SOLARIS and others has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Angles et al., U.S. Pat. No. 6,385,591 B1, cited in the previous Office Action (hereafter referred to as “Angles”) in view of Greenberg, U.S. Pat. App. Pub. No. 2003/0144913 A1 (hereafter referred to as “Greenberg”).

Referring to claim 1. Angles discloses a method for facilitating interaction between a consumer and a merchant (*see, e.g.*, Figure 3), said method comprising:

- receiving offer information from said merchant via a broadcast that reaches a plurality of potential consumers, wherein said offer information relates to a product (*e.g.* Fig. 3, col. 7, line 65 through col. 8, line 5 and col. 9, lines 37-44 – note that the offer received via broadcast could be an advertisement on an electronic page (i.e. a website) or viewed by interactive television);
- retrieving consumer preference information from a database resident on equipment associated with the consumer (*e.g.* Fig. 3, col. 8, lines 19-24 and line 61 through col. 9, line 1, and col. 19, lines 53-63 – note the consumer preference information is incorporated in the consumer code embodied in the cookie)
- customizing said offer information received from the merchant via the broadcast with the consumer preference information to create an amended offer (*e.g.* Fig. 3, col. 8, lines 24-30, col. 9, lines 1-4 and col. 20, line 60 through col. 21, line 18); and
- transmitting said amended offer to a display for viewing by said consumer (*e.g.* Fig. 3, col. 8, lines 28-30 and col. 9, lines 5-10).

Angles does not disclose transmitting the amended offer specifying a method of acceptance, receiving an acceptance, from said consumer, wherein said acceptance is associated

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with said amended offer and said acceptance includes a security feature, amending acceptance with consumer payment information and identification information to create an amended acceptance and transmitting said amended acceptance to said merchant.

Greenberg, in the same field of endeavor of electronic shopping, discloses a method and apparatus for conducting electronic commerce where an email offer is sent to prospective customers including:

- wherein the offer specifies a method of acceptance (Fig. 2 and pages 1-2, ¶¶0016 and 0018 – note the method of acceptance is the “Purchase ‘button’”);
- receiving an acceptance, from said consumer, wherein said acceptance is associated with the offer and the acceptance includes a security feature (Figs. 2 and 3, and page 2, ¶0018 – note the security feature can be either the one embedded on a credit card or the SSL handshaking and certificate exchange);
- amending acceptance with consumer payment information and identification information to create an amended acceptance (page 2, ¶0021 – note the consumer payment information and identification are in the email in advance and the amended acceptance is performed by activating the “Purchase Using Default Options” button); and
- transmitting said amended acceptance to said merchant (Fig. 3 and page 2, ¶¶0019 and 0021 – note the transmittal is performed by notifying the merchant server).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Angles to include the teachings of Greenberg to allow for transmitting the amended offer specifying a method of acceptance, receiving an acceptance from the consumer, wherein the acceptance is associated with the amended offer and includes a

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security feature, amending acceptance with consumer payment information and identification information to create an amended acceptance, and transmitting said amended acceptance to said merchant. Doing so would allow for an electronic purchase to be conducted after an offer to sell is made, thereby leading to more business transactions completed and more profit.

Referring to claim 2. Angles in view of Greenberg further discloses the method of claim 1 wherein said transmitting said amended offer to a display includes transmitting via at least one of television programming and web broadcast (Angles, col. 9, lines 37-44).

Referring to claim 3. Angles in view of Greenberg further discloses the method of claim 1 wherein said receiving offer information includes receiving offer information relating to a product which includes at least one of a good, item, service, and soft good (Angles, *e.g.*, col. 15, lines 44-54).

Referring to claim 4. Angles in view of Greenberg further discloses the method of claim 1 wherein said receiving an acceptance from said consumer includes receiving an acceptance via at least one of a remote control, electronic pen, telephone, automatic dialing device, microphone, pager, radio frequency device, personal digital assistant, smart card, DVR, PVR, and simulated button (Angles, col. 10, lines 43-52 and Greenberg, pages 1-2, ¶0016 – note the computer can be a number of mechanisms, including a personal digital assistance, interactive television and wireless device, and that the acceptance can be any mechanism, including a mouse click, to indicate acceptance) in order to complete and effect a purchase.

Referring to claim 5. Angles in view of Greenberg discloses the method of claim 1 wherein said acceptance includes a security feature including at least one of authentication, embedded certificates, consumer ID and password, identifier, data encryption, digital signature, secure file structures, and trusted third party downloads (Greenberg, Figs. 2 and 3, and page 2, ¶¶ 0018, 0021 and 0022 – note the security feature can be consumer ID and password, the one embedded on a credit card or the SSL handshaking and certificate exchange) in order to prevent fraudulent purchases and/or uses of credit cards.

Referring to claim 6. Angles in view of Greenberg also discloses the method of claim 1 further including a registration process (Angles, col. 14, lines 22-63).

Referring to claim 7. Angles in view of Greenberg also discloses the method of claim 1 further including at least one of authenticating the consumer (Angles, col. 19, lines 53-63 – note the authentication is extracting the consumer code and determining whether the user has registered), restricting access to certain portions of said method (Angles, col. 15, lines 32-43 – note the restricting is performed by only allowing consumers to view the advertisement most appropriate for them) and managing consumer identities (Angles, *e.g.*, col. 16, lines 10-19 – note the management of consumer identities is the storing of information based on the consumer code).

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Referring to claim 8. Angles in view of Greenberg also discloses the method of claim 1 further comprising analysis of attributes of said consumer to substantially predict offer content and context (Angles, *e.g.*, col. 16, lines 10-19 – note the analysis is based on consumer profile).

Referring to claim 9. Angles in view of Greenberg further discloses the method of claim 1 wherein said amending acceptance with consumer payment information includes amending acceptance with at least one of consumer loyalty point information, authorization from an issuer, authorization from said system, security or wallet server authorization, consumer authentication and single use account number information (Greenberg, page 2, ¶0021 – note the acceptance includes authorization from user, security server authorization and single use account number information from credit card) in order to complete transactions in a timely manner.

Referring to claim 10. Angles in view of Greenberg also discloses the method of claim 1 further comprising developing at least one of a consumer transaction database and an offer evaluation database (Angles, col. 16, lines 10-20).

Referring to claim 11. Angles in view of Greenberg further discloses the method of claim 1 wherein said transmitting said amended acceptance to said merchant includes at least one of authenticating and authorizing a transaction (Greenberg, Fig. 3 and page 2, ¶¶0019 and 0021) in order to complete the transaction.

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Referring to claims 12 and 13. All of the limitations in apparatus claim 12 are closely parallel to the limitations of method claims 1-11, analyzed above and are rejected on the same bases.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Walker et al., U.S. Pat. App. Pub. No. 2002/0169664 A1, discloses a system for providing customized offers on a billing statement (*see, e.g.*, Figs. 17 and 18, and pages 2-12 and 15-18).

(2) Koga et al., U.S. Pat. App. Pub. No. 2002/0004748 A1, discloses a system, method and medium for customizing, storing and forwarding offers broadcast via satellite (*see, e.g.*, pages 6-13).

(3) Banerjee et al., U.S. Pat. App. Pub. No. 2002/0147638 A1, discloses a method and system for customizing offers to consumers based on location (*see, e.g.*, pages 8-13).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

July 28, 2006



Jeffrey A. Smith
Primary Examiner